

Amendment and Response

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Serial No.: 09/997,931

Confirmation No.: 5355

Filed: November 30, 2001

For: CIRCULAR DNA VECTORS FOR SYNTHESIS OF RNA AND DNA

REMARKS

The Office Action mailed February 23, 2005 has been received and reviewed. Claims 96, 97, 100, 113 and 115 having been amended, the pending claims are claims 96-115, 117, 120 and 121. Of these, claims 98, 117, 120 and 121 have been allowed, and claims 96, 97 and 99-115 are rejected. Reconsideration and withdrawal of the rejections in view of the amendment and accompanying remarks is respectfully requested.

Claims 96, 97, 100, 113 and 115 are amended to recite that the cell into which the oligonucleotide template is introduced is not located inside a living whole organism. Support for this amendment is found, for example, page 32, lines 15-16, where it is stated that "[t]he cell can, for example, be in cell culture (*ex vivo*), or it can be present in a living whole organism, such as a plant or animal (*in vivo*)."

Rejection under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 96, 97, 99, 100-115 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claimed invention is so broad as to include methods of nucleic acid based treatment and further, that the specification does not provide any structure that would define, as a class, molecules that may treat any particular disease. Further, the Examiner asserts that the rejected claims read on both the members of group I and II of the restriction requirement of record. The Examiner suggests that the claims be amended to read on only the elected invention, i.e., to not read on the method in a whole organism and therefore on gene therapy for example.

This rejection is respectfully traversed; however, in order to advance prosecution, claims 96, 97, 100, 113 and 115 are amended to recite that the cell into which the oligonucleotide template is introduced is not located inside a living whole organism. It is submitted that the claims, as amended, now read only on the invention of Group I, and that the rejection is thereby obviated. Reconsideration and withdrawal of the rejection of claims 96, 97, 99, 100-115 under 35 U.S.C. §112, first paragraph, is respectfully requested.

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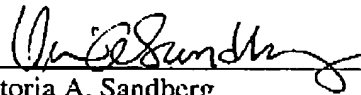
For: CIRCULAR DNA VECTORS FOR SYNTHESIS OF RNA AND DNA**Summary**

Claims 98, 117, 120 and 121 having been allowed in the Office Action mailed February 23, 2005, it is respectfully submitted that the remaining claims 96, 97 and 99-115 are now also in condition for allowance, and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Eric T. Kool

By
Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415
Phone: (612) 305-1220
Facsimile: (612) 305-1228
Customer Number 26813

May 23, 2005
Date

By: 
Victoria A. Sandberg
Reg. No. 41,287
Direct Dial (612) 305-1226

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of May, 2005, at 10:27am (Central Time).

By: Name: SARA E. OLSON